

## **REMARKS/ARGUMENTS**

Upon entry of this amendment, claims 12 and 15 will be canceled without prejudice or disclaimer of the subject matter recited therein, and claims 1, 13, 14 and 16 will be amended. Applicants reserve the right to submit the subject matter prior to the present amendment in one or more continuation and/or divisional applications, and are not expressing any agreement or acquiescence with the rejections set forth in the Office Action. Claims 1-11, 13, 14 and 16 remain pending, with claims 1 and 10 being independent claims.

By the amendment herein, claim 1 has been amended as to matters of form, and the amendments to claims 13, 14 and 16 are discussed in the response to the enablement rejection below.

Entry of this amendment after final rejection is appropriate in that the amendment is directed to matters of form with respect to claim 1, and is in response and to reduce issues associated with the 35 U.S.C. 112, first paragraph, enablement rejection.

Reconsideration and allowance of the application are respectfully requested.

### **Discussion Of Interview**

Applicants express appreciation for the courtesies extended by the Examiner to Applicants' representative Arnold Turk during an August 2, 2007 personal interview at the Patent and Trademark Office.

During the interview, the Examiner was requested to vacate the Final Office Action as not clearly applying the 35 U.S.C. 112, first paragraph rejection including addressing the recitation of diseases in Applicants' claims 15 and 16; and for apparently inconsistent treatment of claims including rejection of narrow claims, such as claim 2, without rejection of broader claims, such as

claim 1. The Examiner would not agree to vacate the Final Office Action, but indicated that arguments should be presented in a response, and he would reconsider his position.

The Examiner did agree that claim 2 was a proper dependent claim for the reasons that are set forth in the present response.

During the interview, Applicants' representative noted that EP 1136482 A1 (EP'482), WO 01/70729 A1, U.S. Patent No. 6,844,335 B2 ('335 patent), and U.S. Application No. 11/035,264 ('264 application) are family members, and the Examiner was shown a printout of an ep.espacenet.com family list and a printout from the US PAIR system to show that the documents are family members, and have similar disclosure. Copies of these documents are attached to the present response to ensure a complete record. The Examiner reviewed this information, and acknowledged that he believed that the evidence presented in Applicants' Declaration with the last response was sufficient to overcome the teachings of EP '482 in view of the superior results shown therein, and therefore he withdraw the rejection based upon EP '482.

However, the Examiner indicated that the claimed subject matter of the '335 patent and the '264 application was sufficient to support obviousness-type double patenting rejections. Applicants' representative questioned the difference between the obviousness-type double patenting rejections and the withdrawn rejection based upon EP '482, and the Examiner again indicated the superior showings in the Declaration convinced him to withdraw the rejection based upon EP '482.

Regarding the 35 U.S.C. 112, first paragraph, enablement rejection, the Examiner indicated that the Patent and Trademark Office is getting stricter with respect to claims that do not recite specific diseases, but are directed to function. Moreover, the Examiner indicated that arguments would need to be presented showing that one having ordinary skill in the art had sufficient

guidance for treating specific diseases. The Examiner also indicated that the rejection of prevention would be maintained.

### **Indication Of Allowable Subject Matter**

Claims 1 and 10 are indicated to be allowed barring finding of any prior art in a subsequent search.

Applicants therefore request that the Examiner indicate that claims 1 and 10 remain allowed, and that each of the pending claims that depend directly or indirectly upon claim 1, i.e., claims 2-9, 11, 13, 14 and 16, be indicated to be allowable.

### **Response To Examiner's Comments Regarding Claims 2-11**

On page 10, second paragraph of the Office Action, the Examiner notes that claims 2-11 are improper dependent claims as they permit  $m=0$ , a choice that is not recited in claim 1. The Examiner has not rejected the claims based on this issue.

Applicants submit that claim 2 recites that each of  $p$ ,  $q$  and  $r$  can be 0; however, claim 2 also recites that  $p + q$  is 1 or 2. Therefore, each of  $p$  and  $q$  cannot simultaneously be 0. Thus, claim 2 and claims 3-9 which depend directed or indirectly from claim 2 should be appropriate dependent claims.

Moreover, claim 10 is independent and claim 11 depends upon claim 1. Accordingly, the Examiner's comment does not apply to these claims.

### **Information Disclosure Statement**

Applicants express appreciation for the inclusion with the Final Office Action of an initialed copy of the Form PTO-1449 submitted with the Information Disclosure Statement, filed March 14, 2007, whereby the Examiner's consideration of the Information Disclosure Statement is of record.

### **Claim Of Priority**

Applicants again express appreciation for the acknowledgement of the claim of foreign priority as well as receipt of the certified copy of the priority application. In this regard, Applicants again note that the box on the Cover Sheet of the Office Action, Form PTOL-326, should indicate that the certified copy has been received in this National Stage application from the International Bureau.

### **Rejection Under 35 U.S.C. 112, first paragraph**

Claims 12-16 are rejected under 35 U.S.C. 112, first paragraph, as the rejection asserts that the specification, while being enabling for treating, does not reasonably provide enablement for treating and preventing any or all diseases including any or all neurodegenerative diseases and any or all cancers by inhibiting tau protein kinase embraced in the claim language.

In this ground of rejection, it appears that the Examiner is rejecting the claims as being broadly directed to inhibiting tau protein kinase, and alleges that Applicants are therefore asserting that any and all neurodegenerative diseases and any and all cancers can be treated. The rejection contends that such claims are reach through claims. The rejection is also objecting to prevention language

included in the claims. The rejection does not address the specific diseases recited in claims 15 and 16.

In response, and in an attempt to advance prosecution of the application without expressing any agreement or acquiescence with the rejection of record, Applicants have amended the claims in the present amendment to advance the application to allowance.

Thus, claims 12 and 15 have been canceled without prejudice or disclaimer of the subject matter recited therein.

Claims 13, 14 and 16 have been amended to avoid the use of preventive.

Claim 13 has been amended to so that the claims is directed to a method for therapeutic treatment of a disease selected from Alzheimer disease and non-insulin dependent diabetes.

Claim 14 has been amended to recite that the neurodegenerative disease is selected from Alzheimer disease, ischemic cerebrovascular accidents, Down syndrome, cerebral bleeding due to cerebral amyloid angiopathy, progressive supranuclear palsy, subacute sclerosing panencephalitic parkinsonism, postencephalitic parkinsonism, pugilistic encephalitis, Guam parkinsonism-dementia complex, Lewy body disease, Pick's disease, corticobasal degeneration, frontotemporal dementia, vascular dementia, traumatic injuries, brain and spinal cord trauma, peripheral neuropathies, retinopathies, and glaucoma, as previously recited in claim 15.

Claim 16 has been amended to delete certain diseases so that the recited diseases include a disease selected from non-insulin dependent diabetes, obesity, manic depressive illness, schizophrenia, and alopecia.

Applicants submit that the claimed subject matter is enabled so that one having ordinary skill in the art would be cable of practicing Applicants' claimed subject matter without undue experimentation, whereby the enablement rejection should be withdrawn. Applicants note that the

claims are directed to subject matter that is not included in the enablement rejection, and therefore the enablement rejection is without appropriate basis, and should be withdrawn.

### **Response To Obviousness Type Double Patenting Rejections**

In the Final Office Action, the following obviousness-type double patenting rejections are set forth.

(a) Claims 2-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,844,335.

(b) Claims 2-9 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 11/035,264.

Initially, Applicants note that the rejection over the '335 patent is unclear, because the statement of the rejection refers to claim 1 of the '335 patent; whereas, the body of the rejection refers to claims 1-50 of the '335 patent. Therefore, clarification of this ground of rejection is requested.

Applicants note that, as discussed with the Examiner during the above-noted interview, independent claim 1 has not been rejected over prior art, and the Examiner has indicated at the above-noted interview that the evidence presented in Applicants' Declaration with the last response was sufficient to overcome the teachings of EP '482 in view of the superior results shown therein, and therefore the Examiner withdraw the rejection based upon EP '482. In particular, as noted above, during the interview, Applicants' representative noted that EP'482, WO 01/70729 A1, the '335 patent, and the '264 application are family members, and the Examiner was shown a printout of an ep.espacenet.com family list and a printout from the US PAIR system to show that the documents are family members, and have similar disclosure, and copies of these documents are

attached to the present response. The Examiner reviewed this information, and acknowledged that he believed that the evidence presented in Applicants' Declaration with the last response was sufficient to overcome the teachings of EP '482 in view of the superior results shown therein, and therefore he withdraw the rejection based upon EP '482.

Therefore, as claims 2-9 and 11 depend directly or indirectly from independent claim 1, claims 2-9 and 11 should also be patentable, at least for the reason that the Examiner is not rejecting claim 1 and has indicated claim 1 to be allowed. Therefore, these grounds of rejection should be withdrawn.

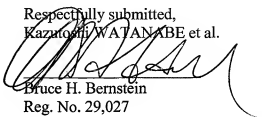
### CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Kazutoshi WATANABE et al.

  
Bruce H. Bernstein  
Reg. No. 29,027

September 5, 2007  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Arnold Turk  
Reg. No. 33094